

No. 05-1455

In the
United States Court of Appeals
for the Federal Circuit

SOLICITOR

AUG - 1 2006

U.S. PATENT & TRADEMARK OFFICE

IN RE RONALD A. SCHACHAR,

Appellant.

APPEAL FROM THE UNITED STATE PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES
APPLICATION SERIAL NO. 09/589,626

**COMBINED PETITION FOR PANEL REHEARING
AND PETITION FOR REHEARING EN BANC**

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

IN RE SCHACHAR v. _____

No. 05-1455

CERTIFICATE OF INTEREST

Counsel for the (petitioner) (appellant) (respondent) (appellee) (amicus) (name of party)

RONALD A. SCHACHAR certifies the following (use "None" if applicable; use extra sheets if necessary):

1. The full name of every party or amicus represented by me is:

RONALD A. SCHACHAR

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

REFOCUS GROUP INC.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

4. ☒ There is no such corporation as listed in paragraph 3.

5. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

John J. Butrus, William A. Munck, Daniel E. Venglarik, DAVIS MUNCK, P.C. (f/k/aNOVAKOV, DAVIS & MUNCK P.C., f/k/a NOVAKOV DAVIS P.C.)07.28.06

Date



Signature of counsel

John J. Butrus

Printed name of counsel

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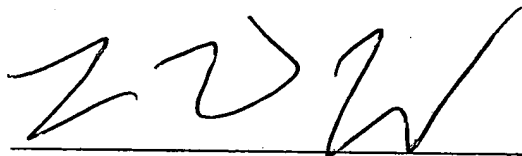
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STATEMENT REGARDING REHEARING EN BANC

Based on my professional judgment, I believe this appeal requires an answer to one or more precedent-setting questions of exceptional importance:

1. Whether the USPTO is required to explicitly identify claim terms asserted to be ambiguous, and to provide express interpretations of such claim terms, prior to the close of prosecution on an application as part of their burden of identifying specific objections that can be met by the applicant rather than simple general rejections; and
2. Whether an express disclaimer of broad interpretation of claim terms within the specification of a patent application may be made by amendment to the specification during prosecution, or must be found in the specification as originally filed.

A handwritten signature in black ink, appearing to read 'JJB', is written over a horizontal line.

John J. Butrus

POINTS OVERLOOKED OR MISAPPREHENDED

Appellants respectfully submit that the panel of the Court overlooked or misapprehended the following points of law or fact in the judgment without opinion entered June 14, 2006:

1. No assertion of ambiguity in the claim terms was made prior to the close of prosecution, nor was any interpretation of the “ambiguous” claim terms contrary to that asserted by Dr. Schachar was proffered by the Patent Office prior to close of prosecution; and
2. Express disclaimer of the broader interpretation asserted by the Patent Office may be made in the specification, including by amendments to the specification after filing.

ARGUMENT

- I. **The claim terms were not found “ambiguous,” and no interpretation of the claim terms was proffered by the Patent Office, until after the close of prosecution on this application.**

This appeal involves an unfortunate example of “laying behind the log.” The government claims, and the Board of Patent Appeals found, that the term “ends” in Dr. Schachar’s patent application was ambiguous in that the term could mean “attached ends” or “non-attached ends.” *Appellee’s Brief* at p. 11; A5. However, the Examiner never disclosed this ambiguity to Dr. Schachar. Through his silence, the

Examiner denied Dr. Schachar the opportunity to resolve this ambiguity, and to avoid this costly appeal.

At oral argument, the Solicitor urged that Dr. Schachar had the obligation to amend the claims to eliminate any ambiguity therein, citing *In re American Academy of Science Technology Center*, 367 F.3d 1359 (Fed. Cir. 2004) and *In re Biggio*, 381 F.3d 1320 (Fed. Cir. 2004).

However, by statute the Patent Office has the burden of establishing that an applicant is not entitled to a patent as claimed. *In re Epstein*, 32 F.3d 1559, 1570 (Fed. Cir. 1994) (Plager, J., concurring), citing *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992) (Plager, J., concurring) and *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967), cert. denied, 389 U.S. 1057; see also 35 U.S.C. § 102 (“A person shall be entitled to a patent unless . . .”). As part of that burden, the Patent Office is required to set forth specific objections that can be met by the applicant, and not just make general rejections. *In re Epstein*, 32 F.3d at 1570; see also *In re Oetiker*, 977 F.2d at 1449 (Plager, J., concurring) (“The examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection harbored by the examiner.”).

In the subject application, the final rejection provided no notice that the term “ends” was considered ambiguous as to whether the “ends” must be attached or non-

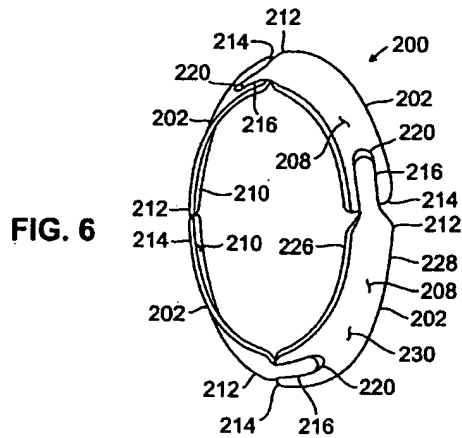
attached. Instead, the Examiner simply asserted that the completed structure in the cited prior art included “ends,” without proffering any interpretation for that claim term:

The Applicant’s remarks have been reviewed. The Applicant states that “[t]here is no first end and there is no second end of the scleral expansion band described in the *Schachar* reference” (Paper No. 12, page 16, lines 7–8) and thus ignores the embodiment that is explicitly characterized as having ends (column 7, lines 6–8). Moreover, it must be pointed out that the transitional term “comprising” is “inclusive or open-ended and does not exclude additional, unrecited elements” (MPEP 2111.02). Therefore, even though the scleral expansion band mentioned at column 7, lines 1–3, for example, is ring-like in form, it comprises a plurality of parts or bodies, each of which has first and second ends, a planform, and other features set forth in present claim 1 and others.

A51. The scleral expansion band described at column 7, lines 1–3 of the ‘331 patent, referenced in the above quote, is formed from a plurality of segments affixed end-to-end:

The scleral expansion band may also be made in a plurality of parts that can be assembled prior to use or may be installed separately to form a complete band.

US 5,354,331, column 7, lines 1–3. An example of such a band is depicted in Dr. Schachar’s United States Patent No. 6,197,056:



The final rejection in the subject application gave no notice to Dr. Schachar that the Examiner (a) considered the claim term “ends” to be ambiguous, or (b) interpreted the claim term “ends” differently than as used in the specification, as a free and/or unattached “end.” Instead, the Examiner simply indicated that he considered the “ends” of a structure to continue to exist even after that end is affixed to the end of another structure to form a continuous band.

Thus, contrary to the Solicitor’s assertions, Dr. Schachar had no notice of any ambiguity in the claims that required clarification by amendment thereof until after the close of prosecution by filing of a Notice of Appeal to the Board of Patent Appeals and Interferences (“BPAI”). Only on appeal did the Examiner first assert that the claim term “ends” did not require such ends to be free or unattached. A76. Moreover, neither the Examiner nor the BPAI ever explicitly asserted any ambiguity of the claim term “ends.” To the contrary, the term was simply accorded a broad

definition inconsistent with the usage within the specification, without any indication that the term was perceived to be ambiguous.

Therefore, Appellant respectfully requests that this application be remanded with instructions to withdraw the finality of the Office Action mailed August 14, 2003, to afford Dr. Schachar the opportunity to address the interpretation of the term “ends” that was first adopted by the Patent Office after the close of prosecution.

II. An “ambiguity” in claim terms may be addressed by amendment of the specification to include an express definition and/or disclaimer.

As mentioned above, the ambiguity in the term “ends” (*i.e.* whether this term includes only free “ends” or also includes affixed “ends”) is a critical issue with respect to the patentability of Dr. Schachar’s invention. In fact, at oral argument, the Solicitor urged that Dr. Schachar was obligated to amend the claims in order to eliminate “ambiguity” of terms thereof. Dr. Schachar has attempted to amend the scope of its claims, as indicated by the attached Amendments to the Specification. The only remaining issue is whether an amendment to the specification at this time is sufficient to define the term “ends,” or whether such amendment must be included in the claim language itself.

It is well established that “[t]he patentee is free to act as his own lexicographer, and may set forth any special definitions of the claim terms *in the patent specification*

or file history, either expressly or impliedly.” *Schoenhaus v. Genesco, Inc.*, 440 F.3d 1354, 1358 (Fed. Cir. 2006), citing *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1300 (Fed.Cir.2004). The proposed amendment to the Schachar application clearly relates to the definition of the term “ends,” and is not simply a preferred embodiment of the invention. *Cf. LG Electronics, Inc. v. Bizcom Electronics, Inc.*, 2006 WL 1867475 (Fed. Cir., July 7, 2006).

There is good reason for Dr. Schachar to amend the definition of the term “ends” (to mean only non-attached ends) in the specification, rather than in the claim itself. Claims, by their nature, are intended to be fairly brief. A more thorough definition may be made in the specification, without introducing superfluous language to the claims. Accordingly, Dr. Schachar prefers not to amend the claims, but to amend the specification to expressly define the term “ends” instead.

Anticipating that the Patent Office will object to and/or refuse entry of such an amendment, and in the interest of judicial economy, Dr. Schachar requests the Court determine that the proposed disclaimer may be added to the specification at this time.

To that end, Dr. Schachar is concurrently submitting a Supplemental Amendment and Response to Final Office Action in the application that amends the specification by replacing the paragraph bridging page 13, line 14 through page 14, line 8 (A30–A31) with follows (inserted text underlined):

Turning initially to FIGURE 1, illustrated a top plan view of an advantageous embodiment of an improved scleral prosthesis in accordance with the principles of the present invention. To overcome the above-identified deficiencies of the circumferential body prosthesis, the improved prosthesis of the present invention comprises a body (generally designated 100), having a first end and a second end (generally designated 105a and 105b, respectively), that is adapted to expand a contacted sclera to increase the effective working distance of the ciliary muscle of the eyeball while providing means for stabilizing the prosthesis relative to the contacted sclera. As used herein, the term "end" or "ends" refers to an end that is unattached to, and not in contact with, other portions of the prosthesis body, such as the other end 105a or 105b or a central portion of the body 100 between those ends. Ends 105a and 105b are thus spaced apart from one another, and are not looped around past each other such that body 100 forms a continuous band. The body 100 includes a top surface 110 that may suitably be adapted to contact ocular tissue within a pocket (or loop) surgically formed within the sclera of the eyeball. Surgical procedures for suitably forming an appropriate scleral pocket are described in the above-incorporated patent documents and further discussion is not necessary for the purposes of this patent document. Exemplary top surface 110 is illustratively shown having a convex planform.

This amendment, which merely defined a claim term, does not constitute new matter under 35 U.S.C. § 132(a). Accordingly, a directive to the USPTO that this amendment should be entered is respectfully requested.

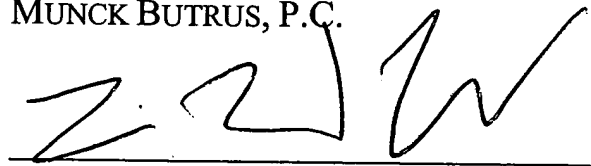
CONCLUSION

Dr. Schachar was not notified of the asserted ambiguity of the claim term "ends" during prosecution of the subject application. Nor was any interpretation of that claim term expressly proffered by the Examiner prior to the close of prosecution,

on appeal. Therefore Dr. Schachar should be afforded the opportunity to meet this objection. Moreover, Dr. Schachar should be permitted to meet this objection in the manner of his choosing: by amendment of the specification to include an express definition of the claim term "ends," rather than by amendment of the claims.

Respectfully submitted,

MUNCK BUTRUS, P.C.

A handwritten signature in black ink, appearing to read 'J. Butrus', written over a horizontal line.

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ATTORNEYS FOR APPELLANT

ADDENDUM

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

NOTICE OF ENTRY OF
JUDGMENT WITHOUT OPINION

JUDGMENT ENTERED: 06/14/06

The judgment of the court in your case was entered today pursuant to Rule 36. This Court affirmed the judgment or decision that was appealed. None of the relief sought in the appeal was granted. No opinion accompanied the judgment. The mandate will be issued in due course.

Information is also provided about petitions for rehearing and suggestions for rehearing in banc. The questions and answers are those frequently asked and answered by the Clerk's Office.

Regarding exhibits and visual aids: Your attention is directed to FRAP 34(g) which states that the clerk may destroy or dispose of the exhibits if counsel does not reclaim them within a reasonable time after the clerk gives notice to remove them. (The clerk deems a reasonable time to be 15 days from the date the final mandate is issued.)

JAN HORBALY
Clerk

cc: DANIEL E. VENGLARIK
JOHN M. WHEALAN

IN RE SCHACHAR, 2005-1455
PTO - BPAI-EP, 09/589,626

DOCKETED
JUN 19 2006

RECEIVED

JUN 19 2006

MUNCK BUTRUS

NOTE: Pursuant to Fed. Cir. R. 47.6, this disposition
is not citable as precedent. It is a public record.

United States Court of Appeals for the Federal Circuit

05-1455
(Serial No. 09/589,626)

IN RE RONALD A. SCHACHAR

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

JUN 14 2006

JUDGMENT

JAN HORBALY
CLERK

ON APPEAL from the

United States Patent and Trademark Office
Board of Patent Appeals and Interferences

In CASE NO(S).

Serial No. 09/589,626

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED: AFFIRMED. See Fed. Cir. R. 36

Per Curiam (NEWMAN, LINN, and PROST, Circuit Judges).

ENTERED BY ORDER OF THE COURT

DATED: JUN 14 2006



Jan Horbaly, Clerk

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing COMBINED PETITION FOR PANEL REHEARING AND PETITION FOR REHEARING EN BANC are being served on the following parties by the methods indicated on July 28, 2006:

Party Served

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Mr. Rob McManus, Esq.
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Method(s) of Service

Federal Express

07.28.06

Date



John J. Butrus